

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Shuwu Wu et al.

Art Unit : 2645

Serial No. : 09/810,159

Examiner : Nguyen, Trong Nhan P.

Filed : March 19, 2001

Title : VOICE INSTANT MESSAGING

MAIL STOP AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY TO ACTION OF APRIL 19, 2006

Claims 1-25, 37-39 and 41-44 are under consideration, with claims 1, 21, 22 and 44 being independent. Claims 27-36 have been withdrawn.

Independent claims 1, 21, 22 and 44, and their dependent claims (i.e., claims 2-20, 23-25, 37-39 and 41-43) have been rejected as being unpatentable over Cook (U.S. Patent No. 6,879,665) in view of PowWow (NPL dated 3/1/2000). Applicants respectfully traverse this rejection.

Independent claims 1, 21 and 22, as amended, each recite, among other features, “enabling presentation of a first text instant messaging graphical user interface to the recipient that includes a display of the message text and an icon, the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message between the sender and the recipient” (emphasis added) and “enabling manipulation by the recipient of the icon to invoke voice communications”. Applicants request reconsideration and withdrawal of the rejection of claims 1, 21 and 22, and their dependent claims, because neither Cook, PowWow, nor any proper combination of the two describes or suggests enabling presentation of the recited text instant messaging graphical user interface (GUI) including a display of an icon and a message text of a text instant message, the icon being manipulable by the recipient of the text instant message to invoke voice communications, wherein the presentation of the GUI is conditioned on communication of the text instant message between the sender and the recipient.

Cook describes an e-mail system that has been modified to support the communication of voice messages. As stated in the response to the Final Office Action of December 2, 2005,

Cook's system is substantially different from an instant messaging system. The Examiner acknowledges Cook's failure to teach instant messaging but refers to PowWow as rectifying this deficiency:

However, Cook does not explicitly indicate that the text message is an instant message. PowWow teaches a similar system as Cook that facilitates voice instant messages. Furthermore, a voice chat can be carried out in a plurality of ways. In all such cases, one must have a connection with a person. In one method, if a user is connected via instant messaging, an icon labeled the voice button can be activated and thus initiate a voice chat (see Method 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of PowWow into those of Cook to make the system versatile. In analogous art such as Cook, one would have a greater advantage in providing features such as voice messaging, integrated voice chat, instant messaging, and point to multi-point communications.

See Final Office Action, pages 3 and 4 (emphasis added).

PowWow teaches client software that supports "instant voice messaging and integrated voice chat capabilities" and "instant messaging, buddy lists, and real-time point-to-multi-point communications and telephony." See PowWow, page 1, lines 21-25 of the Dialog Global Reporter printout. As such, it is unclear how the Examiner is contending that the teachings of PowWow remedy the deficiency of Cook to describe or suggest instant messaging features.

If the Examiner is suggesting that PowWow's teachings would lead one of ordinary skill in the art to convert the e-mails and e-mail features (relied upon by the Examiner to reject various claims) in Cook's e-mail system into instant messages and instant messaging features, applicants respectfully disagree. PowWow teaches an entirely stand-alone instant messaging system that, aside from both dealing with electronic communications between users, has little to nothing to do with an e-mail system.

If the Examiner is suggesting that PowWow's teachings would somehow enable one of ordinary skill in the art in view of Cook to supplement the e-mail features of Cook's system with PowWow's instant messaging features "to make the system versatile." It is unclear how or in what fashion these two disparate systems could be combined into a new universal communications system. Specifically, PowWow fails to disclose the concept of integrating its teachings into other communication systems or types, or otherwise applying them to other such systems or types. Absent such teachings, or any suggestion by either reference of the same, a contention that the two would be combinable in this manner is necessarily premised on impermissible hindsight, leading to an improper combination.

And, even if we assume (for the sake of argument) that a suggestion is made by either of Cook or PowWow for their integration, the combination fails to meet the claimed invention. Stated differently, even if Cook's e-mail system could somehow be properly modified to become an e-mail/instant messaging system that not only includes the e-mail functionality described by Cook but also includes the instant messaging functionality described by PowWow, this new system would still fail meet the recited limitation of enabling presentation of a GUI that includes the recited icon and the recited instant message text of a text instant message, the presentation of the GUI being conditioned on communication of the text instant message between the sender and the recipient.

Specifically, PowWow teaches multiple methods of establishing a voice chat between users through use of a Personal Communicator window in a GUI of PowWow's client software. While PowWow describes a user selecting a Voice Button, which the Examiner equates to the recited icon, in the Personal Communicator window to invoke voice communications between the user and one or more other users, PowWow does not describe or suggest that the personal communicator window also displays instant message text of a text instant message and that presentation of the Personal Communicator window is conditioned on communication of the text instant message between the user and another user. Rather, PowWow is careful to teach that the Voice button is "displayed only when two or more people are connected through the Personal Communicator," providing no description or suggestion that the connection between the users and subsequent display of the voice button, much less the display of the Personal Communicator window, is conditioned on receipt or delivery of a text instant message by the user from/to another user. See page 2 of web printout of PowWow.

For at least these reasons, applicants request reconsideration and withdrawal of the rejection of claims 1, 21 and 22, and their dependent claims 2-20, 23-25, 37-39 and 41-43.

Independent claim 44 recites, among other features, "receiving, from a sender, a text instant message addressed to a recipient," "determining, in response to receipt of the text instant message, the capabilities of the recipient to accept voice communications" (emphasis added) and "enabling presentation of a first text instant messaging graphical user interface to the recipient that includes a display of the message text and includes an icon, the presentation of the first text instant messaging graphical user interface being conditioned on whether the recipient is

determined to be capable of accepting voice communications” (emphasis added). As stated in the response to the Final Office Action of December 2, 2005, Cook does not describe or suggest the above-recited instant messaging features, including presentation of the recited GUI being conditioned on whether a recipient is determined to be capable of voice communications in response to receipt of a text instant message by the recipient. For at least the reasons described above, PowWow does not rectify the deficiency of Cook with respect to conditioning the presentation of the above-recited GUI. Accordingly, applicants request reconsideration and withdrawal of the rejection of claim 44.

Applicant submits that all claims are in condition for allowance.

Applicants do not acquiesce in the Examiner's characterizations of the art. For brevity and to advance prosecution, however, applicants may have not addressed all characterizations of the art and reserve the right to do so in further prosecution of this or a subsequent application. The absence of an explicit response by the applicants to any of the Examiner's positions does not constitute a concession of the examiner's positions. The fact that applicant's comments have focused on particular arguments does not constitute a concession that there are not other arguments for patentability of the claims. All of the dependent claims are patentable for at least the reasons given with respect to the claims on which they depend.

No fees are believed due. Please apply any charges or credits to deposit account 06-1050.

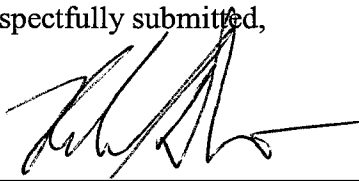
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Respectfully submitted,

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